

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: LOWLES, Robert, J.
Serial No.: 10/787,173
Filed: February 27, 2004
Title: HOLSTER FOR SUPPORTING AND CHARGING THE WIRELESS
HEADSET OF HANDHELD DEVICES
Group: 2617
Examiner: MEHRPOUR, Naghmeh
Attorney Ref.: PAT 53955-2 US

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Alexandria, VA 22313-1450

April 14, 2008

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Applicant submits this request pursuant to the Pre-Appeal Conference Pilot Program described in the United States Patent and Trademark Office OG Notice "New Pre-Appeal Brief Conference Pilot Program," dated 12 July 2005. This request is filed together with a Notice of Appeal. Review of the matters identified below by a panel of examiners is requested because the rejections of record clearly exhibit legal and/or factual deficiencies. Applicant reserves all rights to address the matters herein and any additional matters on appeal in a subsequent appeal brief.

Summary of Claimed Subject Matter

The claims of the present application provide for releasably retaining a peripheral device so that a charging port of a mobile device retained in a sleeve is in direct physical and electrical contact with a charging contact extending from the peripheral device to allow the mobile device to charge a battery in the peripheral device through the charging contact. The direct physical and electrical contact permits direct charging of the peripheral device from the mobile device, without intermediary electrical connections. Thus, compactness and portability are provided along with a long-lasting power supply for extended use between charging by connection to an external source.

Deficiency #1: The Examiner has not provided any rebuttal of arguments raised in Applicant's reply prior to issuing a final office action.

It is respectfully submitted that the Examiner has not set forth sufficient basis on which to maintain the rejections set forth in the Final Office Action. In accordance with MPEP 706.07 FINAL REJECTION, the Final Action "should include a rebuttal of any arguments raised in the applicant's reply". The Examiner, however, has failed to address the arguments raised in Applicant's reply. In particular, in the "Response to Arguments" in the Final Office Action, the Examiner has repeated, word-

for-word, the previously presented "Response to Arguments" set forth in the Final Action dated May 17, 2007 and in the Office Action dated July 17, 2007. The Examiner has not responded to the arguments set forth in either of the responses to these Office Actions, however. For example, the Examiner states that "In response to the applicant's argument that "Christal and Kim fails to teach a mating structure for releasably retaining the peripheral device in direct electrical contact with the mobile device when retained in the sleeve so as to permit the mobile to charge a battery in the peripheral and the features of the present application (such as direct physical contact) does not thought by the references" and provides a response beginning at page 11 of the Final Action dated December 13, 2007. This section, as quoted by the Examiner, is not found anywhere in applicant's response of November 21, 2007, however. Thus, the Examiner's response is not responsive to the arguments made in Applicant's prior response. Furthermore, this section as quoted by the Examiner was not presented in Applicant's response dated July 5, 2007.

Further still, the Examiner states "In response to applicant's argument that there is no suggestion to combine the references..." and includes a response at page 12 of the Final Action. Applicant, however, did not present the argument referred to by the Examiner in Applicant's response of November 21, 2007. In fact, this argument was not presented in the Applicant's response dated July 5, 2007. Again, the Examiner's response is not responsive to the arguments made in Applicant's prior response. Instead, the Examiner has ignored Applicant's clarifying amendments and arguments made in an effort to advance prosecution and has simply repeated prior arguments without any response to Applicant's arguments made in the response dated November 21, 2007.

Applicant telephoned the Examiner on February 21, 2008 to discuss the final office action and, in accordance with Examiner's instructions, followed up with a submission after final action explaining the error on February 25, 2007 in an attempt to elicit a response to Applicant's arguments presented in Applicant's response of November 21, 2007. Applicant's Agent telephoned Examiner again March 10, 2008 to follow up and was advised that Examiner would respond to Applicant's submission. An advisory action was mailed on April 1, 2008 which maintained the rejections of all claims on file. The advisory action again repeated paragraphs from the "Response to Arguments" beginning at page 11 of the final office action dated December 13, 2007, which was repeated from the "Response to Arguments" beginning at page 11 of the office action dated August 23, 2007. In fact, the "Response to Arguments" in the advisory action and in the office action of August 23, 2007 and the final office action of December 13, 2007 is repeated, word-for-word, from the "Response to Arguments beginning at page 11 of the final office action of May 17, 2007.

Thus, the Examiner has not responded to Applicant's clarifying amendments in the response dated November 21, 2007. It is therefore believed that the Examiner has not set forth sufficient basis for maintaining the rejection of the claims presently on file.

Deficiency #2: The Christal Reference does not Anticipate Claims 21 and 22

Claims 21 and 22 stand rejected under 35 U.S.C. § 102(a) as the Examiner asserts that these claims are anticipated by German Patent Document DE 10134830 A1 to Christal. In rejecting Claim 21, the Examiner asserts that Christal teaches a charging contact for providing a charge to the battery when placed in direct electrical contact with a charging port of a mobile device so as to permit the mobile device to charge the battery in the peripheral device. The Applicant disagrees.

In order to anticipate, the cited reference must teach each and every element of the claim. Claim 21 recites “an integral charging contact for providing a charge to the battery when placed in direct physical and electrical contact with a charging port of the mobile device so as to permit the mobile device to charge the battery in the peripheral device”. Thus, the peripheral device includes an integral charging contact for providing the charge to the battery when placed in direct physical and electrical contact with the charging port of the mobile device.

The Christal reference teaches the use of intermediary electrical conductors for electrical contact of the mobile device with the peripheral device. Thus, the mobile device and the peripheral device are not in direct physical contact with each other. Furthermore, the electrical contacts shown in Figure 2C, a portion of which is shown in Figure 2B, are clearly part of the holding device and are not part of the peripheral device. This is clear from the description of, for example, Figure 2B which clearly states “in the Fig. 2b has represented this holding device without the mobile telephone 2 and without the microphone headphone unit 3”. Figure 2B, however, clearly shows the electrical contact 14 as part of the electrical conductors 19. Similarly, the electrical contacts 14 and 15 of the “distance piece” described in the cited reference are part of the bag 4, as disclosed in paragraph [0031] which discloses that “distance piece 1 is in or at the bag 4”. Thus, the electrical conductors shown in the German Reference are clearly not part of the peripheral device for wireless communication with the mobile device. It is therefore believed that the Christal reference cannot possibly anticipate claim 21 of the present application, which requires that the peripheral device include an integral charging contact for providing a charge to the battery when placed in direct physical and electrical contact with a charging port of the mobile device.

Claim 22 includes all the limitations of independent 21 and, accordingly, it is believed that this claim also fully distinguishes over the cited reference.

Deficiency #3: The claimed subject matter is not obvious

Claims 1- 3, 6-9, 11-20, and 23 have been rejected under under 35 U.S.C. § 103(a) as the Examiner asserts that these claims are unpatentable over the Christal reference in view of Korean Patent Document KR 2002041098A to Kim. The Applicant respectfully disagrees.

It is clear from claim 1 that the charging contact is part of the peripheral device (integral with) and the charging contact (that is part of the peripheral device) is in direct physical and electrical contact

with the mobile device retained in the sleeve so as to permit the mobile device to charge a battery in the peripheral device through the charging contact of the peripheral device. Thus, the peripheral device is in direct physical and electrical contact with the mobile device.

Similarly, it is clear from independent claim 12 that the peripheral device has a battery and a charging contact. It is also clear that the holster is for receiving and retaining both the peripheral device and the mobile device so that the charging port and charging contact (which is part of the peripheral device) are in direct physical and electrical contact

As indicated above, the Christal reference teaches that the charging contacts of the peripheral device are connected to electrical contacts of the mobile device only through intermediary electrical conductors (with associated intermediary electrical contacts) of the holding device. There is absolutely no disclosure of a charging contact that is integral with the peripheral device being in direct physical and electrical contact with the mobile device.

Korean Patent Reference KR 2002041098A to Kim teaches the use of an intermediary connector such as a cable having a jack for attaching a cellular phone and a cordless headset. While Kim teaches the use of such a connector for charging the battery in the peripheral device from the battery of the mobile device, Kim fails to disclose a charging contact of the peripheral device being in direct physical and electrical contact with the mobile device. Instead, an intermediary connector is required. Therefore, the Kim reference fails to cure the deficiencies of the Christal reference as the Kim reference clearly teaches the use of a connector for connecting the cellular phone with the cordless headset.

Neither of the cited references disclose a mating structure for releasably retaining the peripheral device such that a charging contact that is integral with the peripheral device (or part of the peripheral device) is in direct physical and electrical contact with the mobile device. Instead, both references teach the use of intermediary conductors. Further still, there is no direct physical contact between any part of the peripheral device and the mobile device in either of the references. Thus, these references even when combined cannot possibly render claims 1 and 12 as obvious.

With respect to claim 11, the Examiner asserts that the Christal reference teaches the headset in direct physical and electrical contact with the mobile device at paragraphs 31 and 33. There is no such disclosure, however. These paragraphs of the cited reference disclose the use of a "distance piece" as an intermediary between the mobile device and headset. Referring to Figure 1 of the cited reference, the headset sits in a front pocket while the mobile phone is placed in the larger pocket (9). The two devices are connected by the intermediary distance piece (1) that is part of or in the bag (4). Similarly, Figure 2 shows a headset mounted to a device that includes the intermediary conductor 19. The mobile phone also mounts to the same device, adjacent the headset, as best shown in Figure 2A. Neither the Figures nor the associated description teaches or suggests the two devices in direct physical and electrical contact, as

required by claim 11. The Kim reference completely fails to cure the deficiencies of the Christal reference and therefore the combination of the cited references cannot possibly arrive at the presently claimed invention. Claim 11 is therefore believed to fully distinguish over the cited references.

Claims 2, 6-9, 13, 14, 17-20 and 23 include at least all of the limitations of one of independent claims 1, 11, and 12 and accordingly, it is believed that these claims also fully distinguish over the cited references.

Claim 10 has been rejected under 35 U.S.C. §103(a) as being unpatentable over the Christal and Kim references as applied to claim 1 and further in view of United States Patent Application 2004/0116161A1 to Grivas et al. Applicant respectfully disagrees.

As indicated above, the Christal and Kim references do not disclose a mating structure for releasably retaining the peripheral device such that a charging contact integral with the peripheral device is in direct physical and electrical contact with the mobile device. The Grivas reference fails to cure the deficiencies of the Christal and Kim references. In particular, the Grivas reference teaches the use of an intermediary connector between a camera peripheral device and a mobile device, as clearly shown in Figure 1. It is therefore believed claim 10 fully distinguishes over the Grivas reference when taken alone and when combined with the cited Christal and Kim references.

Based on the foregoing, it is believed that the Examiner has not set forth sufficient basis on which to maintain the rejections set forth in the Final Office Action. With respect to the Examiner's 102(a) rejection, Applicant submits that the Christal reference does not anticipate claims 21 and 22 of the present application. Regarding the Examiner's 103(a) rejection, Applicant submits that the claims on file are not obvious in view of the cited references.

Applicant authorizes the Commissioner to debit any required fee from Deposit Account No. 501593, in the name of Borden Ladner Gervais LLP. The Commissioner is further authorized to debit any additional amount required, and to credit any overpayment to the above-noted account.

Respectfully submitted,
Robert J. LOWLES

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| PRE-APPEAL BRIEF REQUEST FOR REVIEW | | Docket Number (Optional) PAT 53955-2 | | | | | | | | | |
| I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)] on _____ Signature _____ Typed or printed name _____ | Application Number 10/787,173 | Filed February 27, 2004 | | | | | | | | | |
| | First Named Inventor Robert J. LOWLES | | | | | | | | | | |
| | Art Unit 2617 | Examiner Naghmeh MEHRPOUR | | | | | | | | | |
| <p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p> <p>I am the</p> <table style="width: 100%;"><tr><td style="width: 50%; vertical-align: top;"><input type="checkbox"/> applicant/inventor.</td><td style="width: 50%; text-align: center;">_____ /Geoffrey de Kleine/ Signature</td></tr><tr><td style="vertical-align: top;"><input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)</td><td style="text-align: center;">_____ Geoffrey de Kleine Typed or printed name</td></tr><tr><td style="vertical-align: top;"><input checked="" type="checkbox"/> attorney or agent of record. Registration number 50,216</td><td style="text-align: center;">_____ (604) 687-5744 Telephone number</td></tr><tr><td style="vertical-align: top;"><input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____</td><td style="text-align: center;">_____ April 14, 2008 Date</td></tr></table> <p>NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.</p> | | | | <input type="checkbox"/> applicant/inventor. | _____ /Geoffrey de Kleine/ Signature | <input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96) | _____ Geoffrey de Kleine Typed or printed name | <input checked="" type="checkbox"/> attorney or agent of record. Registration number 50,216 | _____ (604) 687-5744 Telephone number | <input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____ | _____ April 14, 2008 Date |
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| <input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96) | _____ Geoffrey de Kleine Typed or printed name | | | | | | | | | | |
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